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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,025	09/28/2000	Charles Eric Hunter	WT-10	7653

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EXAMINER
DINH, DUNG C

ART UNIT	PAPER NUMBER
2152	

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/675,025	HUNTER ET AL.	
	Examiner	Art Unit	
	Dung Dinh	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 December 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-133* is/are pending in the application.

4a) Of the above claim(s) *See Continuation Sheet* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,6-9;13-17,21-52,57-72,76-82,86-99,103-113 and 117-128* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *08 September 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *7/24/02*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims withdrawn from consideration are 3-5,10-12,18-20,54-56,73-75,83-85,100-102,114-116 and 129-133.

DETAILED ACTION

Applicant elected group I for examination is noted. The examiner mistakenly grouped claims 3-5, and 10-12 with group I. Claims 3-5 and 10-12 recite subject matter of group II. Therefore, group I now consists of claims 1-2, 6-9, 13-17, 21-52, 57-72, 76-82, 86-99, 103-113, 117-128 and are pending for examination.

Claims 29, "the predetermined time of day" lack antecedent basis. Claims 29 should be dependent upon claim 28 instead of 15.

Claim Rejections - Obviousness Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 29, and 48 of copending US application 09/385,671. Although the conflicting claims are not identical they are not patentably distinct from each other because the claims of 09/385,671 contains all the limitations of the current claims 1 and 8 except for the limitation of billing the customer for making copies on removable media. It would have been obvious to bill the customer for making copies on removable media because it would have increased revenue from the movie. This is a provisional obviousness double patenting because the claims of 09/385,671 have not in fact patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 15-17, 21-25, 51, 52-53, 57-60, 63-64, 70-89, 92-93, 95-99, 103-108, 110-113, 117-123, 127-128 are rejected under 35 U.S.C. 102(e) as being unpatentable over Russo US patent 5,619,247.

As per claim 15, Russo teaches

transmitting plural digital content the customer [inherent];

permitting the customer to preselect desired content and to create a copy on removable storage medium [see col.4 lines 15-25 - optical discs];

transmitting information from the customer to a central controller system to verified that content has been copied and display therefrom [col.6 lines 25-32, col.11 lines 50-57].

As per claims 16 and 24, Russo teaches permitting the customer to select desired digital data content in the storage medium for viewing and transmitting content display information to a remote location to verify that a preselected content has been viewed (col.11 lines 52-57).

As per claim 17, Russo teaches the storage device being CD or DVD (col.4 line 16 optical discs, col.11 line 44 'digital video disk').

As per claims 21-22, Russo teaches billing the customer only for content that was stored and displayed (col.11 lines 57-59).

As per claims 25, Russo teach compression at transmission and decompression for playback [see fig.2 #112, col.7 lines 37-40].

As per claim 51, Russo teaches crediting the provider upon viewing of content by the customer (col.5 lines 6-10, col.5 lines 32-40).

As per claims 52 and 81, they are rejected under similar rationale as for claims 15 above. Russo teaches automatic selection of program for recording according to predetermined criteria (col.4 lines 65 to col.5 line 4).

As per claims 53 and 82, Russo teaches the storage device being CD or DVD (col.4 line 16 optical discs, col.11 line 44 'digital video disk').

As per claims 57 and 86, Russo teaches billing the customer only for content that was stored and displayed (col.11 lines 57-59).

As per claims 58-59, Russo teaches the content includes video and audio (col.7 lines 5-10).

As per claims 60, Russo teach compression at transmission and decompression for playback [see fig.2 #112, col.7 lines 37-40].

As per claims 63-64, 92-93, Russo teach the criteria being based on preference manually entered by the customer [col.4 lines 65+].

As per claims 70-72, it is rejected under similar rationale as for claims 15-17 above.

As per claims 76-77, Russo teaches billing the customer only for content that was stored and viewed (col.11 lines 57-59).

As per claim 78 and 87, Russo teaches the monitor for playback video image (fig.1 #8).

As per claims 79 and 88, Russo teaches audio data playback (col.7 lines 5-10). It is apparent that the system would have speaker for playback of audio.

As per claims 80 and 89, Russo teach compression at transmission and decompression for playback [see fig.2 #112, col.7 lines 37-40].

As per claim 95, Russo teaches a user station comprising:

a receiver for receiving a transmission of plural digital content [fig.1];

removable storage memory [col.4 lines 16-17 optical discs];

selection means for informing the user of the content received and for selecting content stored in the removable storage memory for display [col.5 lines 55-65].

As per claim 112, it is rejected under similar rationale as for claim 95 above. Russo teaches means for automatic selection of content for storage (col.4 lines 65 to col.5 line 5).

As per claims 96, 127-128, Russo teaches mean for customer to preselect content for storage (col.4 line 65 to col.5 line 5) and permitting the customer to display preselected content from the storage (col.5 lines 55-65).

As per claims 97 and 98 and 120s, Russo teaches transmitting means for transmitting billing information only for content that was stored and displayed [col.5 lines 7-16].

As per claims 99 and 113, Russo teaches the storage device being CD or DVD (col.4 line 16 optical discs, col.11 line 44 'digital video disk').

As per claims 103, 104 and 117, Russo teaches a display for displaying the content stored (fig.1 TV#8).

As per claims 105 and 118, Russo teach vide image (movies) and the display is a monitor (TV).

As per claims 106 and 119, Russo teaches the content includes audio (col.7 lines 5-10). It is apparent that the playback device would have a speaker (for example the TV#8).

As per claims 107 and 121, Russo teaches the receiver can be satellite, cable, internet, and telephone receiver (col.6 lines 16, col.8 lines 19-23, col.9 lines 20-33).

As per claims 108 and 123, Russo teach compression at transmission and decompression for playback [see fig.2 #112, col.7 lines 37-40].

As per claim 110, Russo teaches providing and navigating schedule listing (col.9 lines 1 to 19).

As per claim 111, Russo teaches the means for navigating includes a plurality of buttons (fig.2 remote control #163).

As per claim 122, Russo teaches the storage device being selected from the group consisting of hard drive, optical drive, magnetic drive and magneto-optical drive (col.4 lines 15-27).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> *(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*

Claims 1-2, 6-9 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russo US patent 5,619,247 and further in view of Walters et al. US patent 5,440,334.

As per claim 1, Russo teaches a method of distributing movies comprising:

transmitting plural movies to plural customer households [inherent];

permitting the customer to record and playback any of the recorded movies [col.4 to col.5];

communicating playback information to a central controller system and using the information for billing the customer for only the movies that are played back for viewing [col.5 lines 1-5, col.6 lines 25-32].

Russo does not teach a system where the movies are transmitted faster than real-time to the customers. In similar field of invention, Walters teaches that it is advantageous to compress video and audio programs in time-compressed format so as to enable transmission of the program faster than real-time to the customer for storage [see col.2 lines 12-27, col.7 lines 8-14]. Hence, it would have been obvious for one of ordinary skill in the art to combine the teaching of Walters with Russo for the many

advantageous as discloses by Walters. (See Walters col. 7 lines 8 to 60).

Russo teaches storing the movies on high capacity storage medium and removable medium (col.4 lines 15-27: disk array, optical discs, video cassette). Russo does not teach billing separately for copying from the high capacity storage to removable media for play back. It would have been obvious for one of ordinary skill in the art to separate the playback right on mass storage from that of removable media because it would have created additional source of revenue for the movie.

As per claim 8, it is reject under similar rationale as for claim 1 above. It is apparent that Russo would have had a database storing customer information so as to enable the system to bill the customer.

As per claim 2, Russo teaches the removable media being a CD or DVD (col.4 line 16 optical discs, col.11 line 44 'digital video disk').

As per claims 6 and 14, Russo teaches copying in companion to a set-top box connected to a satellite or cable TV (fig.1, col.6 line 16).

As per claim 7, Russo teaches using broadcast satellite transmission (col.6 line 16).

As per claim 9, Russo teaches the removable media being a CD (col.7 line 51). It is apparent that Russo would have had a CD read/write device to record movie onto CD media.

As per claim 13, Russo teaches usage of digital video disk (col.11 line 45). Russo does not specifically disclose DVD read/write device. DVD read/write device is well known at the time of the invention. It would have obvious for one of ordinary skill in the art to have DVD read/write device because it permit more storage than CD media.

Claims 26-33, 47-50, 61-62, 65, 66-69, 90-91, 94, 109, 124-126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russo US patent 5,619,247.

As per claims 26-29, Russo does not specifically teach transmitting more content during prime viewing period. It is well known that more viewers tune in during prime period and demand for new release is more than for old material. Hence, it would have been obvious to one of ordinary skill in the art to provide more content during prime viewing period because it would have enable more selections, thereby satisfies more demands from the customers.

As per claims 30-32, Russo teaches transmitting content listing and schedule information (col.8 line 64 to col.9 line

5). It is apparent that the information would be periodically updated.

As per claim 33, it would have been obvious for one of ordinary skill in the art to displaying content by category so as to enable the user to easily navigate the content offered.

As per claim 37-38, Russo teaches remotely providing enable signal to the display device (col.6 lines 20-21).

As per claims 47-50 and 109 and 124, Russo does not specifically disclose detecting error and enabling repair. Russo teaches that the customer is not charged (i.e. provider is not credited) until the customer actually viewed the content. Hence, it would have been obvious to notify the customer of error in the content and permit repair so as to enable the customer to actually view the content.

As per claims 61, 90 and 125, Russo does not specifically teach the criteria being random periodic basis. It would have been obvious to based on random periodic because it would have spread out the requests from customers and reduces peaks traffic on the system.

As per claims 62, 91 and 126, Russo does not specifically teach the criteria being based on popularity of the content. It would have been obvious to base on popularity of the content

because it would have been most likely content that the customer would want.

As per claims 65 and 94, Russo does not specifically teach including information in header of the content to enable matching to customer preference. It is well known in the art to include identification information in the header. It would have been obvious for one of ordinary skill in the art to have information in the header to enable matching because it would have enabled efficient identification of the broadcast content.

As per claims 66-69, Russo teaches erasing content (col.5 lines 10-13, col.11 lines 20-25). Russo does not specifically disclose overriding oldest content, older release or least fit. The replace criteria recited would have been obvious to one of ordinary skill in the art. It would have been obvious for replace oldest or old release because it would have been least likely to be view by the user again. It would have been obvious to replace using least fit so as to minimize the number of content that would need to be erase to make room for the new content.

Claims 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russo and further in view of Rabowsky US patent 6,141,530.

As per claims 34-36, Russo does not teach preventing playback on an unauthorized device. However, in similar field of content transmission, Rabowsky teaches Control Assess System to encode the content so as to permit only playback on authorized device (see col.6 lines 5-23, col.6 line 58 to col.7 line 4). Hence, it would have been obvious for one of ordinary skill in the art to combine the teaching of Rabowsky with Russo because it would have improved the security of the system and reduced pirating.

Claims 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russo and further in view of Leighton US patent 5,949,885.

As per claim 39-40, Russo does not specifically disclose altering the content with a digital watermark to identify the customer. Leighton discloses that it is well known in the art to alter digital content with digital watermark identifying the purchaser of the digital content (see col.1 lines 33-43). This enable unauthorized copy to be traced back to the originator. Hence, it would have been obvious to one of ordinary skill in the art to watermarking the content because it would have enabled tracking back to the source of any unauthorized distribution of the content.

Claims 41-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russo and further in view of Hoffberg et al. US patent 6,400,996.

As per claims 41-45, Russo teaches including soundtrack (col.7 lines 5-10). Russo does not teach including additional information according to predetermine criteria. In similar field of invention, Hoffberg teaches to include promotional material optimized for a particular viewer and the viewer is credited for viewing the material [col.59 lines 34-50]. Hence, it would have been obvious for one of ordinary skill in the art to include additional material such as promotional materials with the preselected content because it would have enhanced revenue via sponsorship fees and reduced the viewer cost.

As per claim 46, it would have been obvious to advise the customer of the storage of the additional information so as to enable the customer to have the opportunity to choose to have the material or not.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung Dinh whose telephone number is (571) 272-3943. The examiner can normally be reached on Monday-Friday from 7:00 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached at (571) 272-3949.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dung Dinh
Primary Examiner
April 26, 2005